



Serial No.: 10/075,747

Confirmation No.: 9474

Applicant: GROWCOCK et al.

Atty. Ref.: 11836.0703.NPUS00

**REMARKS:****REMARKS REGARDING CLAIMS AMENDMENTS:**

The above noted amendments to the claims have been made so that the scope and language of the claims is more precise and clear in defining what the Applicants consider to be the invention. Specifically, claims 1-24 and 58 have been canceled without prejudice, and claims 25-51 are presently withdrawn pending the Examiner's reconsideration of this withdrawal as described below. Claims 52-57 have been amended to address a grammatical error noted by the Examiner and to further define Applicants' claimed invention. Additionally, new claims 60-65 have been added to this application.

Support for the above amendments to the claims can be found in the original specification as filed.

The claims and amended claims are submitted as being clearly distinct and patentable over the art of record and therefore their entry and allowance by the Examiner is requested.



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**IN RESPONSE TO THE OFFICE ACTION:**

**ELECTION/RESTRICTIONS:**

**Applicants respectfully request reconsideration of the withdrawal of claims 25-51 on the following grounds:**

The elected invention (claims 52-59) is directed to a vermiculture composition that includes a plurality of worms; oil contaminated solids, a bulking agent and compostable nitrogen source. The methods recited in claims 25-51 are directed to methods of bioremediation of oil contaminated solids in which the elected invention is utilized at some stage. That is to say, the elected invention is a novel and non-obvious intermediate composition utilized in each of the recited methods. Applicants submit that the law regarding the patentability of intermediate compositions and methods of making and using such compositions is well-known. The MPEP § 2116 et seq. states, "The materials on which a process is carried out must be accorded weight in determining the patentability of a process. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974)." In view of the above, Applicants request the reconsideration and withdrawal of the restriction requirement and rejoinder of claims 25-51 with those of the elected invention (Claims 52-59).

**CLAIM REJECTIONS - 35 U.S.C. § 112:**

In response to the rejection of claims 52-59 as containing the term "the oil contaminated solids," Applicants submit that the language of independent claim 52 speaks for itself and as written this claim is not vague and indefinite. Specifically, claim 52 states "oil contaminated solids...wherein the oil contaminated solids include solid material coated with an oleaginous phase composed of a linear paraffin having 11-18 carbon atoms, a non-oleaginous phase containing a salt of a biodegradable anion, and an emulsifying agent in a concentration capable of forming an invert emulsion suitable for use as a drilling fluid." Claims 53-57, depend from claim 52 and thus the above reasoning applies to these claims as well. Claim 58 has been canceled and claim 59 does not contain the term "oil contaminated solids." Therefore, Applicants traverse this rejection and request the Examiner to reconsider claims 52-57.



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In response to the rejection of claim 56, Applicant has corrected the grammatical error indicated by the Examiner.

With regard to the rejection of claim 59, as containing the term "vermicast," Applicants submit that the term is well-known to one of skill in the art of vermicomposting. Vermicast is the term utilized for the digestive excrement product of the worms utilized in vermicomposting. The term is composed of two portions "vermin" which means pertaining to worms and "cast" which is defined in zoology as being something that is shed, ejected or cast off or out, as molted skin, a feather, food from a bird's crop or the coil of sand and waste passed by certain earthworms. Use of the term can be found at the following Internet Web site <http://www.workingworms.com/compost.html>. In view of the above, Applicants' submit that the term "vermicast" is sufficiently known and defined to one of skill in the art and as such meets the requirements of 35 U.S.C. §112, 1<sup>st</sup> paragraph.

CLAIM REJECTIONS — 35 U.S.C. § 102:

Claims 52-59 have been rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6187581 of Paul Sicotte and Ari Laurell ("Sicotte" reference). In response, Applicants request that the Examiner reconsider and withdraw the rejection in view of the following.

For there to be anticipation under 35 U.S.C. § 102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the



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field of the invention. *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990).

As is clearly taught by the Sicotte reference, the disclosed process and composition for treating hydrocarbon contaminated material is based on the use of microbial cultures capable of metabolizing the hydrocarbon contaminants. See Abstract and Col. 3, lines 15-19; lines 33-37; and independent claims 1 and 7. Nothing in the Sicotte reference teaches or suggests the inclusion of earthworms as the bioremediating agent. Further nothing teaches or suggests the conditions or mixtures and compositions to carry out the effective vermicomposting of oil contaminated solids, such as drill cuttings, drilling mud, contaminated soil and the like. Finally with regard to claim 59, nothing in the Sicotte reference teaches a composition including vermicast (i.e. the digestive excrement product of the worms utilized in vermicomposting) and biodegraded drill cuttings.

In view of the above, Applicants request the reconsideration and withdrawal of the rejection of claim 52-59 under 35 U.S.C. §102 and ask that the Examiner indicate the allowance of the claims in the next paper from the Office.

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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 11836.0703.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.



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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michelle C. Replogle".

Michelle C. Replogle

Patent Attorney

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Date: 03/11/04